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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,269	03/04/2004	Peter Gansen	03100197AA	4232

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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT PAPER NUMBER

1714

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/792,269

Applicant(s)

GANSEN ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/4/04
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Applicant's paper of 7/2/04 stating that the foreign priority papers have been filed is noted. However, the foreign priority document is not seen in the file.

1. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the disclosed "associated derivatives, does not reasonably provide enablement for all of the encompassed "associated derivatives". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

A. - There are an infinite number of "associated derivatives" of the instant claim 2 encompassed by the instant claims. It would require undue experimentation to determine all of the associated derivatives, how to make them, and to figure out which ones function in the instant invention.

2. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. It is unclear what exactly is excluded by "in the absence of amine initiators". Page 5 of the instant specification states that amine started, i.e. initiated polyethers may be used. The instantly claimed component B encompasses amines. Particularly, in the urethane reaction, amines are usually used as chain extenders whereas "initiators" are often thought of as being the compound that "starts" the molecule such as ethylene glycol initiated PEG, AIBN initiated addition polymers, amine initiated polyethers such as the Jeffamines, etc. It is unclear if only these starter molecules are intended to be excluded or if all NH compounds are to be excluded, including chain extenders.

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B. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 2, 3, 12, 13, 15 and 17 recite the broad recitations denoted by "in particular", "preferably", and "more preferably" followed by the narrower recitations.

C. The instant claim 6 recites "parts". It is unclear if the parts are based on weight, moles, volume, or some other basis.

D. The instant claim 8 recites a ratio. It is unclear if the ratio is based on weight, moles, volume, or some other basis.

E. The instant claim 18 recites "obtainable". It is unclear what other foils made by other methods are encompassed by the instant claim due to the recitation of "obtainable". The following are supporting descisions for rejecting "obtainable" and similar terms as indefinite.

1. Atlantic Thermoplastics Co. Inc. v Faytex Corp. 23

USPQ 2nd 1481 (1486).

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In footnote 6, on page 1486, referring to *Cochrane v Badische Aniline and Soda Fabrik* (BASF), 11 US 293, the court stated "...because artificial alizarine can take different forms, BASF's claim would be indefinite unless limited to the described process".

The claim referred to is

"Artificial alizarine produced form anthracene or its derivatives by either of the methods described herein or any other method producing a like result."

2. Ex parte Tanksley 26 USPQ 2nd 1389

"A claim is indefinite if undue experimetnation is involved to determine boundaries of protection".

This rationale is applicable to polymers obtainable by a stated process because any variation in any parameter within the scope of the claimed process would change the polymer produced. One who made or used a polymer made by a process other than the process recited in the claim would have to produce polymers using all possible parameters within the scope of the claims (temperature, pressure, diluents, component ratios, feed ratios, etc.) and then extensively analyze each product, to determine if his polymer was obtainable by a process within the claimed process.

3. *Purdue Research v Watson* 1959 CD 124 (Dist Ct) affirmed by CCPA 120 USPQ 521.

"Preparable by" was held to not particularly point out and distinctly claim the invention.

"When one has produced a composition of matter where it is not possible to define its characteristics which make it inventive except by reference to the process by which it is produced, one is permitted to so claim the composition produced by the process referred to in the claims. When the composton is thus claimed in terms of the process of its preparation, the

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product cannot be defined in such a manner as to assert a monopoly on the product by whatever means produced.

F. The instant claim 1 recites "where appropriate". It is unclear how the skilled artisan is to tell where it is appropriate to use the recited limitations.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-13 and 17-18 are rejected under 35 U.S.C. 102(b and e) as being anticipated by EP 1095993 A2, which is prior art under section b, as translated by US Pat.

Application Pub. No US 2005/0263243 Schumann et al. which is prior art under section e.

Schumann discloses the instantly claimed polyurethane compositions, coated articles and foils at the abstract; sections [0058]. [0094] through [0107] which encompasses the instantly claimed oxide particles, polyisocyanates, polyols, catalyst, [0113], [0115][0119], [0136], [0142]-

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[0221], the claims, and the remainder of the document. The Omyacarb 4BG of the examples would appear to give the function of the instant claim 11.

By definition of average molecular weight, the Mw of section [0101] will necessarily and inherently possess molecules of the instant claim 7. In this atmosphere, the reactants of the reference will necessarily contain small amounts of water which is why the compounds of section [0113] are used. The amount of water is expected to be trace which falls within the scope of the instant claim 6.

5. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over each of EP 1095993 A2 and US Pat. Application Pub. No US 2005/0263243 Schumann et al..

Schumann discloses the instantly claimed polyurethane compositions, coated articles and foils at the abstract; sections [0058]. [0094] through [0107] which encompasses the instantly claimed oxide particles, polyisocyanates, polyols, catalyst, [0113], [0115][0119], [0136], [0142]-[0221], the claims, and the remainder of the document. The Omyacarb 4BG of the examples would appear to give the function of the instant claim 11.

By definition of average molecular weight, the Mw of section [0101] will necessarily and inherently possess molecules of the instant claim 7. In this atmosphere, the reactants of the reference will necessarily contain small amounts of water which is why the compounds of section [0113] are used. The amount of water is expected to be trace which falls within the scope of the instant claim 6.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use spraying of the instant claims 14-16 to apply the above discussed polyurethane because the reference states that application may be done "in a customary coating process" at

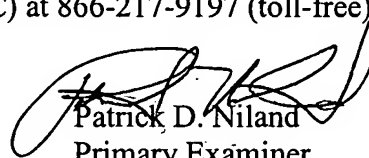
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section [0032] and spraying solutions of coating is one of the most well known and used means to coat from a solution and its benefits such as uniform coating would have been expected in the coating of the references which use the instantly claimed temperatures and thicknesses (section [0170]).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrick D. Niland
Primary Examiner
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